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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,031	04/02/2001	Richard M. Levenberg	PALM-3543.US.P	6920
7590 08/10/2004 WAGNER, MURABITO & HAO LLP Two North Market Street, Third Floor San Jose, CA 95113			EXAMINER MAURO JR, THOMAS J	
			ART UNIT 2143	PAPER NUMBER

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/825,031

Applicant(s)

LEVENBERG, RICHARD M.

Examiner

Thomas J. Mauro Jr.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-31 are pending and are presented for examination. A formal action on the merits of claims 1-31 follows.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites a method for “deleting a second annotation rule set...” which depends from claim 1 above. This presents confusion and indefiniteness as claim 1 makes no mention of a second annotation rule set. Examiner questions how something can be deleted having never been mentioned before. This limitation is only introduced in claim 2; however, claim 4 does not depend from claim 2. Please provide proper basis for claim 4 by appropriately amending claim 1 or changing the dependence of claim 4.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 13 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Jakubowski (US 2002/0143821).

With respect to claim 1, Jakubowski teaches a method for enabling a transcoding proxy server to utilize an annotation rule set in order to transcode a web page for a portable computing device **[Jakubowski -- Abstract]**, said method comprising the steps of:

- (a) a transcoding proxy server receiving a web page request from a portable computing device; and
- (b) said transcoding proxy server transmitting said web page request to a server computer coupled to said transcoding proxy server **[Jakubowski -- Figure 1 and Page 3 paragraph [0025] – Proxy acts as an intermediary between the device and server, thus requests made for pages are received by proxy and then passed on to the server upon which the page is stored];**
- (c) said transcoding proxy server receiving from said server computer a web page element corresponding to said web page request **[Jakubowski -- Figure 1 and Page 3 paragraph [0025] – Proxy receives the content from the webpage specified in the request];**
- (d) said transcoding proxy server locating a first annotation rule set that corresponds to said web page request, wherein said first annotation rule set is distinct from a transcoding

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functionality utilized by said transcoding proxy server **[Jakubowski -- Page 3 paragraph [0025] – Stylesheet corresponding to the web page requested is applied; therefore, the stylesheet, based upon the page requested, is located and loaded]**; and (e) said transcoding proxy server transcoding said web page element for said portable computing device by following said first annotation rule set and utilizing said transcoding functionality **[Jakubowski -- Page 3 paragraph [0025] – Transformation are performed on the webpage based upon the stylesheet to produce a destination, i.e. transformed, page]**.

With respect to claim 13, Jakubowski teaches a computer readable medium having computer readable code **[Jakubowski -- Page 7 paragraph [0049]]**. The remaining limitations of claim 13 are similar to the method claimed in claim 1 above. It has similar limitations; therefore, claim 13 is rejected under the same rationale.

With respect to claim 25, this is a method claim similar to the method claimed in claim 1. In addition, it recites a specific device, namely, a personal digital assistant. Jakubowski teaches portable devices, including, personal digital assistants (PDA's) **[Jakubowski -- Page 1 paragraphs [0002-0003]]**. The remaining limitations are rejected under the same rationale as claim 1.

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6. Claims 1-2 and 13-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Mogul (U.S. 6,704,798).

With respect to claim 1, Mogul teaches a method for enabling a transcoding proxy server to utilize an annotation rule set in order to transcode a web page for a portable computing device **[Mogul -- Abstract]**, said method comprising the steps of:

- (a) a transcoding proxy server receiving a web page request from a portable computing device; and
- (b) said transcoding proxy server transmitting said web page request to a server computer coupled to said transcoding proxy server **[Mogul -- Figure 5, Col. 8 lines 49-51 and Col. 10 lines 7-9 – Client sends request for webpage, i.e. to server, by first transmitting it to proxy server and then the proxy server relays the request to the server];**
- (c) said transcoding proxy server receiving from said server computer a web page element corresponding to said web page request **[Mogul -- Figure 5, Col. 8 lines 53-54 and lines 55-57 and Col. 10 lines 16-24 – Proxy server receives the response, i.e. webpage, from server];**
- (d) said transcoding proxy server locating a first annotation rule set that corresponds to said web page request, wherein said first annotation rule set is distinct from a transcoding functionality utilized by said transcoding proxy server **[Mogul -- Col. 6 lines 56-67 – Col. 7 lines 1-8 and Col. 8 lines 11-14 – Proxy server determines appropriate conversion program, i.e. rule set, and locates it, whether it is cached locally or stored at a remote site accessible by a URL]; and**

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(e) said transcoding proxy server transcoding said web page element for said portable computing device by following said first annotation rule set and utilizing said transcoding functionality [**Mogul -- Figure 5 and Col. 8 lines 16-18 and lines 59-64 -- Conversion program is executed to convert web page, i.e. response, by following one of the multiple conversion programs, i.e. Conversion Program A].**

With respect to claim 2, Mogul further teaches receiving and storing a second rule set while proxy server is operating [**Mogul -- Col. 6 lines 49-67 -- Col. 7 lines 1-16 and Col. 9 lines 1-8 -- Multiple conversion programs, i.e. Prog A -- Prog E, exist and can be downloaded at any time if proxy determines this program should be used for the transcoding. Therefore, reference requires and inherently teaches that after one webpage is requested and Prog. A, i.e. first rule set, is used and stored at proxy, a subsequent request can use Prog. E, second rule set, and therefore proxy receives and stores a second rule set during its operation].**

With respect to claim 13, Mogul teaches a computer readable medium having computer readable code [**Mogul -- Col. 14 lines 4-15].** The remaining limitations of claim 13 are similar to the method claimed in claim 1 above. It has similar limitations; therefore, claim 13 is rejected under the same rationale.

With respect to claim 14, this is a computer readable medium claims corresponding to the method claimed in claim 2 above. It has similar limitations; therefore, claim 14 is rejected under the same rationale.



***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 5-8, 12, 15, 17-20 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mogul (U.S. 6,704,798), as applied to claims 1 and 13 above respectively, in view of Jakubowski (US 2002/0143821).

Regarding claim 3, Mogul teaches the invention substantially as claimed, as aforementioned in claim 1 above, but fails to explicitly teach editing said rule set while said transcoding proxy is operating.

Jakubowski, however, teaches a system for reformatting web content to be displayed on various mobile devices including adding, i.e. editing, templates, i.e. XML stylesheets, by adding various commands and rules from a GUI on a developer workstation **[Jakubowski -- Page 2 paragraph [0022-0023] and pages 3-4 paragraphs [0027-0029]]**.

Both Mogul and Jakubowski teach systems for reformatting data received from a server into another format suitable for a particular device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the adding of rules to conversion templates, as taught by Jakubowski

into the invention of Mogul, in order to provide a mechanism which allows developers to decide how the data is displayed or manipulated thus providing greater customization and flexibility.

Regarding claims 5-6, Mogul teaches the invention substantially as claimed, as aforementioned in claim 1 above, including teaching clients with varying computing and display capabilities [**Mogul -- Col. 7 lines 17-22**].

Mogul, however, fails to explicitly teach using devices such as PDA's and mobile phones.

Jakubowski, however, teaches a system for reformatting web content to be displayed on various mobile devices including PDA's and mobile phones [**Jakubowski -- Page 1 paragraph [0002]**].

Both Mogul and Jakubowski teach systems for reformatting data received from a server into another format suitable for a particular device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate cell phones and PDA's as the portable computing devices, as taught by Jakubowski into the invention of Mogul, in order to extend the capabilities of the transcoding proxy to less powerful computing devices which can benefit from the conversion process by receiving faster, better formatted pages.

Regarding claim 7, Mogul teaches the invention substantially as claimed, as aforementioned in claim 1 above, including teaching clients with varying computing and display capabilities [**Mogul -- Col. 7 lines 17-22**]. In addition, Jakubowski teaches several portable devices, including PDA's and phones [**Jakubowski -- Page 1 paragraph [0002]**].

While Mogul nor Jakubowski explicitly teach the device being a pager, pagers were notoriously

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well-known portable computing devices, at the time of the invention, for receiving various types of information to be displayed in various formats to the user. Therefore, it would have been obvious to incorporate the pager as a portable computing device for use in this system in order to further extend the system's functionality for use in all kinds of portable computing devices.

Regarding claim 8, Mogul-Jakubowski teach the invention substantially as claimed, including wherein said rule set is extensible **[Jakubowski -- Pages 2-3 paragraphs [0023-0024] -- Templates are created using XML, which provides extensibility]**.

Regarding claim 12, Mogul-Jakubowski teach the invention substantially as claimed, including wherein said portable computer device has limited display capability **[Jakubowski -- Page 1 paragraph [0002-0003] -- PDA's have display and bandwidth limitations]**.

Regarding claims 15, 17-20 and 24, these are computer readable medium claims corresponding to the method claimed in claims 3, 5-8 and 12 above. They have similar limitations; therefore, claims 15, 17-20 and 24 are rejected under the same rationale.

Regarding claim 25, Mogul teaches a method for enabling a transcoding proxy server to utilize an annotation rule set in order to transcode a web page for a portable computing device **[Mogul -- Abstract]**, said method comprising the steps of:

- (a) a transcoding proxy server receiving a web page request from a portable computing device; and

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(b) said transcoding proxy server transmitting said web page request to a server computer coupled to said transcoding proxy server [**Mogul -- Figure 5, Col. 8 lines 49-51 and Col. 10 lines 7-9 -- Client sends request for webpage, i.e. to server, by first transmitting it to proxy server and then the proxy server relays the request to the server**];

(c) said transcoding proxy server receiving from said server computer a web page element corresponding to said web page request [**Mogul -- Figure 5, Col. 8 lines 53-54 and lines 55-57 and Col. 10 lines 16-24 -- Proxy server receives the response, i.e. webpage, from server**];

(d) said transcoding proxy server locating a first annotation rule set that corresponds to said web page request, wherein said first annotation rule set is distinct from a transcoding functionality utilized by said transcoding proxy server [**Mogul -- Col. 6 lines 56-67 -- Col. 7 lines 1-8 and Col. 8 lines 11-14 -- Proxy server determines appropriate conversion program, i.e. rule set, and locates it, whether it is cached locally or stored at a remote site accessible by a URL**]; and

(e) said transcoding proxy server transcoding said web page element for said portable computing device by following said first annotation rule set and utilizing said transcoding functionality [**Mogul -- Figure 5 and Col. 8 lines 16-18 and lines 59-64 -- Conversion program is executed to convert web page, i.e. response, by following one of the multiple conversion programs, i.e. Conversion Program A**].

Mogul, however, fails to explicitly teach wherein the portable computer device is a personal digital assistant (PDA).

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Jakubowski, however, teaches a system for reformatting web content to be displayed on various mobile devices including PDA's **[Jakubowski -- Page 1 paragraph [0002]]**.

Both Mogul and Jakubowski teach systems for reformatting data received from a server into another format suitable for a particular device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate PDA's as the portable computing devices, as taught by Jakubowski into the invention of Mogul, in order to extend the capabilities of the transcoding proxy to less powerful computing devices which can benefit from the conversion process by receiving faster, better formatted pages.

Regarding claim 26-27, these are method claims similar to the method claimed in claims 2-3 above. They have similar limitations; therefore, claims 26-27 are rejected under the same rationale.

9. Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mogul (U.S. 6,704,798), as applied to claims 1 and 13 above respectively, in view of Ono (U.S. 6,219,831).

Regarding claim 4, Mogul teaches the invention substantially as claimed, as aforementioned in claim 1 above, including a second rule set **[Mogul -- See rejection to claim 2 above]**.

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Mogul fails to explicitly teach deleting a second annotation rule set while said transcoding proxy is operating.

Ono, however, teaches a system for converting a language in one format into another format by using conversion models/rules which can be edited, deleted, or replaced [Ono -- Col. 5 lines 41-58].

Both Mogul and Ono teach systems for reformatting and converting content received in one language into another language.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the deleting of conversion rules, as taught by Ono into the invention of Mogul, in order to provide a mechanism which allows the developer to have full control over conversion models/rules thus providing greater customization and flexibility.

Regarding claim 16, this is a computer readable medium claim corresponding to the method claimed in claim 4 above. It has similar limitations; therefore, claim 16 is rejected under the same rationale.

10. Claims 9-11 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mogul (U.S. 6,704,798), as applied to claims 1 and 13 above respectively, in view of Huang (US 2002/0133569).

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Regarding claim 9, Mogul teaches the invention substantially as claimed, as aforementioned in claim 1 above, but fails to explicitly teach wherein the annotation rule set contains a URL corresponding to the webpage request.

Huang, however, discloses a transcoding proxy for transforming data from a webpage into a form which can be suitably displayed on a client device and further wherein the transcoding rule contains a URL of the website corresponding to the webpage requested [**Huang – Figure 6, Page 1 paragraph [0012, page 3 paragraph [0035] and page 4 paragraph [0042]]**].

Both Mogul and Huang teach systems for transforming webpage data received in one format into another more suitable format for a given client device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the transcoding rule corresponding to a webpage requested containing the URL, as taught by Huang, into the invention of Mogul, in order to provide better, more accurate transcoding services by generating the rules specifically for a given URL.

Regarding claims 10-11, Mogul teaches the invention substantially as claimed, as aforementioned in claim 1 above, but fails to explicitly teach wherein the rule set corresponds to a class of web pages that share a common webpage object (claim 10) and layout (claim 11).

Huang, however, discloses a transcoding proxy for transforming data from a webpage into a form which can be suitably displayed on a client device and further wherein the transcoding rule correspond to a class of web pages containing a common object [**Huang -- Page 3 paragraph [0035] – Common webpage object is auction item**] and layout [**Huang -- Page 3 paragraph [0035-0036] – Layout shared is the eBay item page format**].

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Both Mogul and Huang teach systems for transforming webpage data received in one format into another more suitable format for a given client device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the transcoding rule corresponding to a class of web pages sharing a common object and layout, as taught by Huang, into the invention of Mogul, in order to provide fast and accurate transcoding services and to provide a simpler and more flexible system by allowing transcoding rules to be shared among similar pages thus reducing the number of transcoding rules which need to be generated.

Regarding claims 21-23, these are medium claims corresponding to the method claimed in claims 9-11. They have similar limitations; therefore, claims 21-23 are rejected under the same rationale.

11. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mogul (U.S. 6,704,798) and Jakubowski (US 2002/0143821), as applied to claim 25 above, in view of Ono (U.S. 6,219,831).

Regarding claim 28, this is a method claim similar to the method claimed in claim 4 above. It has similar limitations; therefore, claim 28 is rejected under the same rationale.



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12. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mogul (U.S. 6,704,798) and Jakubowski (US 2002/0143821), as applied to claim 25 above, in view of Huang et al. (US 2002/0133569).

Regarding claims 29-31, these are method claims corresponding to the method claimed in claims 9-11. They have similar limitations; therefore, claims 29-31 are rejected under the same rationale.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Jamtgaard et al. (U.S. 6,430,624) discloses a content delivery system upon which data is reformatted using specific rules to be displayed on different information appliances.
- Koike et al. (U.S. 6,742,181) discloses a data exchange system which converts data from one format to another format based upon modifiable conversion rules.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mauro Jr. whose telephone number is 703-605-1234. The examiner can normally be reached on M-F 8:00a.m. - 4:30p.m..

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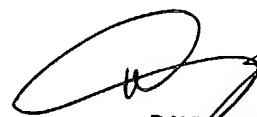
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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TJM

July 29, 2004



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